This action is in response to the communication filed on 11/13/2009.

DETAILED ACTION

Response to Arguments

Applicants' arguments filed 11/13/2009 have been fully considered but the examiner does not find the arguments persuasive.

The applicants basically argue that in Li, the identification process is not completed until the server receives the token from the phone and performs its own verification upon the token. The examiner disagrees with this stance and therefore does not find the argument persuasive. First, the claim language requires that the "identification process" be completed without communicating with the server. As claimed, the "identification process" comprises comparing a stored reference information with a captured reference information. The storing of the reference information is not limited such that the server cannot provide the stored reference information to the portable communication device. In Li, the telephone (FCPD) receives and stores the reference token. Then the telephone captures the biometric and forms a second token, which is compared to the stored reference token. This falls within the scope of the claim language. As far as the claim language requiring that the checking circuit in configured to complete the identification of the client if the read biological information matches with the stored reference biological information, the examiner believes this is also found within Li. In Li, the telephone (FCPD) makes a final determination as to whether the tokens match or not and acts accordingly. When the tokens do not match, the transaction is blocked. Conversely, when the tokens match, the phone decrypts the challenge, and transmits the decrypted challenge to the server. As such, from the standpoint of the telephone, the user has been validated when a match occurs, and

therefore the "identification of the client" is completed. Simply because the server chooses to verify that the challenge data it receives is correct, does not mean that the actual identification of the client was not completed. Completion of the identification of the client occurs when the phone makes the decision as to whether the tokens match, and as such whether to send the appropriate response.

To summarize, in Li, the receiving and storing of the reference token reads on the storing of the reference biological information. The comparison of tokens reads upon the checking and identification process. The transmission of the decrypted challenge and captured token reads on the transmitting information that the identification of the client is completed and the identity of the client is confirmed. And once again, the comparison and decryption do not require communication with the server, as the only communications with the server occur outside of the comparison. Therefore, the examiner maintains that Li, and Nagayoshi meets the limitations of the claim language, and as such, the examiner has rejected the amended claims accordingly below.

Claims 1, 26, 51, 54-60, 62-68, 71-82, 84-85, 88, 92 and 94 have been examined. Claims 2-25, 27-50, 52-53, 61, 69-70, 83, 86-87, 89-91, 93, and 95 have been cancelled.

All objections and rejections not set forth below have been withdrawn.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
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> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an

international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 84-85, are rejected under 35 U.S.C. 102(e) as being anticipated by Li et al. (US Patent Number 6,219,793) hereinafter referred to as Li.

Li disclosed a system for identifying an individual to identify a client, said system comprising a portable communication device having:: a storing means for storing a reference biological information of the client (See Li Fig. 4 Element 404, Col. 10 Lines 57-65 and Col. 12 Lines 20-27); a reading means for reading the biological information of the client (See Li Fig. 4 Element 417); a checking means for performing an identification process to confirm the identity of the client by checking the read biological information with the stored biological information and completing the identification of the client if the read biological information matches with the stored reference biological information (See Li Fig. 4 Element 401 and Col. 12 Lines 8-36 and Col. 10 Line 57- Col. 11 Line 6 Steps 309, 310, and 315); and a transmitting means for transmitting information to the server that the identification of the client is completed and the identity of the client is confirmed (See Li Fig. 4 Elements 402 and 102 and Col. 11 Lines 3-9 Step 311), wherein checking the read biological information with the stored biological information is carried out by using only the portable communication device (See Li Col. 12 Lines 12-17), wherein the checking means is configured to complete the identification of the client without a necessity of exchanging data with the server (See Li Col. 10 Line 57- Col. 11 Line 6 Steps 309, 310, and 315 wherein the comparison of tokens and determination of whether the tokens match occurs without communication with the server).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 92, and 94 are rejected under 35 U.S.C. 103(a) as being unpatentable over Li et al. (US Patent Number 6,219,793) hereinafter referred to as Li.

Li disclosed providing a personal identification number to the phone (Li Col. 15 Lines 15-39) but failed to specifically disclose that in a case that the personal identification number matches with a number stored at the server the stored biological information can be rewritten.

However, it would have been obvious to the ordinary person skilled in the art that in the case that the master user's personal identification number information matched a number stored at the server that the stored biological information could be rewritten. This would have been obvious because the ordinary person skilled in the art would have been motivated to allow an authorized user (a user who's fingerprint matches the master users fingerprint) to update the biological information.

Claims 1, 26, 51, 54-60, 62-68, 71-82, and 88, are rejected under 35 U.S.C. 103(a) as being unpatentable over Li et al. (US Patent Number 6,219,793) hereinafter referred to as Li, and further in view of Nagayoshi et al. (US Patent Number 6,839,798) hereinafter referred to as Nagayoshi.

Regarding claims 1 and 26, Li disclosed a system for identifying a client (See Li Abstract), the system comprising a server and a portable communication device, wherein the

portable communication device comprises: a memory for storing at least one reference biological information of the client using the portable communication device (See Li Fig. 4 Element 404, Col. 10 Lines 57-65 and Col. 12 Lines 20-27); a sensor for reading at least one biological information of the client (See Li Fig. 4 Element 417); a checking circuit for performing an identification process to confirm the identity of the client by checking the read biological information with the stored biological information, wherein the checking circuit is configured to complete the identification of the client if the read biological information matches with the stored reference biological information (See Li Fig. 4 Element 401 and Col. 12 Lines 8-36 and Col. 10 Line 57- Col. 11 Line 6 Steps 309, 310, and 315); and a transmitting circuit for transmitting information the identification of the client is completed and the identity of the client is confirmed to the server (See Li Fig. 4 Elements 402 and 102 and Col. 11 Lines 3-9), wherein the portable communication device is configured to complete the identification of the client without a necessity of exchanging data between the portable communication device and the server (See Li Col. 10 Line 57- Col. 11 Line 6 Steps 309, 310, and 315 wherein the comparison of tokens and determination of whether the tokens match occurs without communication with the server), and wherein the server is configured to transmit the information that the identification of the client is completed to a final end of transaction configured to start a transaction with the client conditioned upon receipt of the information that the identification is complete (See Li Col. 16 Paragraph 2), but failed to specifically disclose that memory 404 was a nonvolatile memory.

However, Li did disclose that the portable communication device could be a phone (See Li Fig. 1), and that the memory 404 stored at least those items necessary to the operation of the fingerprint capturing device including program code for processing, as well as temporary data

(See Li Col. 12 Lines 20-27), and Li further disclosed the use of "routine present-day calling protocol to complete the connection" once the connection was authorized.

Nagayoshi teaches a flash memory device, which can be used in a mobile phone (See Nagayoshi Col. 1 Lines 12-18 and Col. 3 Lines 43-46), for storing nonvolatile data such as rewritten data (See Nagayoshi Col. 1 Lines 60-64) as well as program data (See Nagayoshi Col. 1 Lines 6-18).

It would have been obvious to the ordinary person skilled in the art at the time of invention to employ the teaching of Nagayoshi in the mobile phone system of Li by using the flash memory of Nagayoshi as the memory 404 in Li. This would have been obvious because the ordinary person skilled in the art would have been motivated to provide the needed memory to Li in a small packaging area at a small cost.

Regarding claim 51, Li disclosed a business method using the Internet, said business method comprising: identifying a client by an identifying element loaded in a portable communication device (See Li Fig. 1 Elements 101, 102, and 112 and Fig. 4); and controlling a communication between the client and a plurality of dealers (See Li Fig. 2 Element 202) by a control element in a server (See Li Abstract, and Figs. 3A and 3B); wherein said identifying comprises: reading at least one biological information of the client (See Li. Col. 10 Lines 57-58); and performing an identification process to confirm the identity of the client by checking the read biological information with at least one stored reference biological information of the client in a memory in the portable communication device (See Li Fig. 4 Element 404 and Col. 10 Lines 57-65 and Col. 12 Lines 20-27); using the portable communication device to complete the identification of the client if the read biological information matches with the stored reference

biological information (Li Col. 10 Line 57- Col. 11 Line 6 Steps 309, 310, and 315); and transmitting information that the identification of the client in completed and the identity of the client is confirmed from the identifying element to the control element (See Li Fig. 4 Elements 402 and 102 and Col. 11 Lines 3-9 and Col. 10 Line 57- Col. 11 Line 6 Steps 309, 310, and 315), wherein the identifying step is completed without a necessity of exchanging data between the portable communication device and the server (See Li Col. 10 Line 57- Col. 11 Line 6 Steps 309, 310, and 315 wherein the comparison of tokens and determination of whether the tokens match, which reads on "the identifying step", occurs without communication with the server); and wherein said controlling step comprises: admitting the communication between the client and the plurality of dealers after identifying the client by the identifying element (See Li Col. 11 Lines 19-60); and providing a password to the client (See Li Col. 10 Lines 48-56), and wherein the server is configured to transmit the identification of the client is completed and the identity of the client is confirmed to a final end of transaction configured to start a transaction with the client conditioned upon receipt of the information that identification of the client is completed and the identity of the client is confirmed (See Li Col. 16 Paragraph 2), but failed to specifically disclose that memory 404 was a nonvolatile memory.

However, Li did disclose that the portable communication device could be a phone (See Li Fig. 1), and that the memory 404 stored at least those items necessary to the operation of the fingerprint capturing device including program code for processing, as well as temporary data (See Li Col. 12 Lines 20-27), and Li further disclosed the use of "routine present-day calling protocol to complete the connection" once the connection was authorized.

Nagayoshi teaches a flash memory device, which can be used in a mobile phone (See Nagayoshi Col. 1 Lines 12-18 and Col. 3 Lines 43-46), for storing nonvolatile data such as rewritten data (See Nagayoshi Col. 1 Lines 60-64) as well as program data (See Nagayoshi Col. 1 Lines 6-18).

It would have been obvious to the ordinary person skilled in the art at the time of invention to employ the teaching of Nagayoshi in the mobile phone system of Li by using the flash memory of Nagayoshi as the memory 404 in Li. This would have been obvious because the ordinary person skilled in the art would have been motivated to provide the needed memory to Li in a small packaging area at a small cost.

Regarding claims 54 and 66, Li, and Nagayoshi, disclosed that the nonvolatile memory stores a plurality of reference biological information of the client (See Li Col. 15 Paragraph 3 and Col. 3 Paragraph 3 and Col. 10 Paragraph 4), and wherein the checking circuit is configured to complete the identification of the client if the read biological information has matched with at least one of the stored plurality of reference biological information to the server (See Li Col. 11 Lines 3-9).

Regarding claims 55 and 67, Li, and Nagayoshi disclosed that the sensor reads a plurality of biological information of the client (See Li Col. 15 Paragraph 4), and wherein the checking circuit is configured to complete the identification of the client if each of the plurality of read biological information has matched with at least one of the plurality of stored reference biological information (See Li Col. 11 Lines 3-9).

Regarding claims 56 and 68, Li, and Nagayoshi disclosed that the information that the identification of the client is completed and the identity of the client is confirmed is transmitted to the server through the Internet (See Li Col. 7 Paragraph 2).

Regarding claims 57 and 71, Li, and Nagayoshi disclosed that after transmitting the information that the identification of the client is completed to the server, a personal identification number information is sent to the Server (See Li Col. 15 Paragraphs 3-4).

Regarding claims 58 and 72, Li, and Nagayoshi disclosed that in a case that the personal identification number matches with a number stored at the server, the stored biological information is rewritable (See Li Col. 15 Paragraph 3).

Regarding claims 59-60, 73-74, and 78-79, Li, and Nagayoshi disclosed that the read biological information is one selected from the group consisting of a fingerprint, a palm pattern and a voice print; and that the palm pattern is a whole pattern of the palm or a pattern of a part of the palm (See Li Col. 6 Paragraph 3 and Col. 17 Paragraph 3).

Regarding claim 62, Li, and Nagayoshi disclosed that the sensor includes one of a photodiode and a CCD (See Li Col. 4 Paragraph 6).

Regarding claims 63-65, 75-77, and 80-82, Li, and Nagayoshi disclosed that the portable communication device comprises a portable information terminal; a portable telephone; a personal computer (See Li Col. 5 Line 66 – Col. 6 Line 14).

Regarding claim 88, see the rejection of claims 92 and 94 above.

Conclusion

Claims 1, 26, 51, 54-60, 62-68, 71-82, 84-85, 88, 92 and 94 have been rejected. Claims 2-25, 27-50, 52-53, 61, 69-70, 83, 86-87, 89-91, 93, and 95 have been cancelled.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MATTHEW T. HENNING whose telephone number is (571)272-3790. The examiner can normally be reached on M-F 8-4.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William Korzuch can be reached on (571)272-7589. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Matthew T Henning/
Primary Examiner, Art Unit 2431